

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT C. SALIB and JIANBO LU

Application No. 10/619,051

MAILED

FEB 24 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on January 24, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On April 1, 2004, appellants filed an Information Disclosure Statement (IDS). It is not clear from the record whether the examiner considered the IDS submitted or whether the examiner notified appellants of why the submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

Also, a review of the file reveals that the fee was not charged for the appeal brief filed July 20, 2005. Before further

review of this file, the appeal brief fee must be applied to the appellants' account.

In addition, a review of the file indicates that the appeal brief filed July 20, 2005 has used the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the appeal brief filed on July 20, 2005 does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A

concise statement of each ground of rejection presented for review.

(vii) *Argument.* Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

The following appropriate sections are missing from the appeal brief:

- 1) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37(c)(1)(v);
- 2) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 3) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

A substitute appeal brief that is in compliance with 37 CFR § 41.37 are required. For more information on the Board's new

Application No. 10/619,051

rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Furthermore, on September 27, 2005, the examiner has mailed an examiner's answer. In the Evidence Relied Upon section, page 2, paragraph (8), the examiner has stated that "No evidence is relied upon by the examiner in the rejection of the claims under appeal." A review of the file reveals that a reference to Chubb, US 6,593,849 B2 was applied to the statement of rejection in the Grounds of Rejection section, paragraph (9), of the examiner's answer. Before further review, the examiner must submit a corrected examiner's answer that will include in the Evidence Relied Upon section, the reference to Chubb in the statement of rejection.

Accordingly, it is

ORDERED that this application be returned to the examiner to: 1) consideration of the Information Disclosure Statement filed April 1, 2004; 2) appropriate written notification by the examiner to appellants of such consideration 3) entry of the appeal brief fee; 4) hold the appeal brief of July 20, 2005 defective; 5) request appellants to file a substitute appeal brief in compliance with 37 CFR § 41.37;

Application No. 10/619,051

6) consider the substitute appeal brief; 7) vacate the examiner's answer and issue a revised examiner's answer in response to the substituted appeal brief and to provide the missing reference under the Evidence Relied Upon section; and 8) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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